

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Frank D. Tuttle	Group Art Unit: 3692
Application No.: 09/518,837	Examiner: Frantzy Poinvil
Filed: 03/03/2000	Attorney Docket No.: 800470
Title: Loan Compliance Auditing System and Method	Petitioner and Assignee: Mavent, Inc.

Mail Stop Petition  
 Commissioner for Patents  
 PO Box 1450  
 Alexandria, VA 22313-1450

**PETITION UNDER 37 CFR 1.181(a)****Introduction**

Petitioner and Assignee, Mavent, Inc., files this petition under 37 CFR 1.181(a)(1) for withdrawal of the Examiner's rejection of Applicant's claims 1-42 in the fifth Office Action, and for allowance and issue of U.S. Patent Application No. 09/518,837. The fifth Office Action subsequent to appeal includes rejections of claims 1-42 that have previously been adjudicated and reversed by the Board of Patent Appeals and Interferences.

**Statement of Facts**

Petitioner Mavent, Inc. (formerly Assured Regulatory Compliance, Inc.) has not requested the formalities of 37 CFR 1.181(c) whereby "it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner" because of the circumstances of extended prosecution. This extended prosecution has been stretched over a period of more than seven years, involving five Office Actions and an appeal before the Board of Patent Appeals and Interferences. This extended prosecution included the following activities:

- Patent Application 09/518,837 with 42 claims filed on March 3, 2000
- First Office Action mailed March 4, 2003
- Responded to first Office Action under 37 CFR 1.111 on June 4, 2003
- Second Office Action mailed September 8, 2003
- Responded to second Office Action under 37 CFR 1.111 on December 8, 2003
- Third and Final Office Action mailed March 9, 2004
- Responded to third and Final Office Action under 37 CFR 1.111 on May 7, 2007
- Filed a Notice of Appeal on June 8, 2004 and related Appeal Brief on August 2, 2004
- The Office reopened prosecution and mailed a fourth Office Action on November 4, 2004
- Responded to fourth Office Action under 37 CFR 1.111, requested reinstatement of Appeal and filed Supplemental Appeal Brief on December 21, 2004
- The Board of Patent Appeals and Interferences reversed the Examiner's rejection of all 42 claims on March 24, 2006
- Fifth Office Action mailed on February 7, 2007

These prosecution activities are summarized in greater detail in Table 1 and Table 2. Table 1 tabulates a prosecution history summary of this case and Table 2 is a historical summary of the claim rejections and responses filed in the various Office Actions and on appeal. The prosecution history may be substantiated by review of the contents in the application file wrapper.

In the fourth Office Action, the Office rejected claims 1-20, 22-33, 39 and 41-42 under 35 U.S.C. § 102(e) as being anticipated by Acosta et al. (U.S. Patent No. 6,643,625), and rejected claims 21, 34-38 and 40 under 35 U.S.C. § 103(a) as being unpatentable over Acosta et al. (U.S. Patent No. 6,643,625).

Subsequent to the fourth Office Action, the Board of Patent Appeals and Interferences reversed the Examiner's rejections of all 42 claims.

In the fifth Office Action subsequent to Appeal, the Office rejected claims 1-42 under 35 U.S.C. § 103(a) as being unpatentable over Acosta et al. (U.S. Patent No. 6,643,625), using the same arguments as those in the fourth Office Action that were reversed on appeal. Although not explicitly stated in the Fifth Office Action, the reopening after a final decision of the Board of Patent Appeals and Interferences appears to be based on 37 CFR 1.198. The fifth Office Action was signed by the Primary Examiner and an Acting Director. See 37 CFR 1.198 is below:

**37 CFR 1.198 Reopening after a final decision of the Board of Patent Appeals and Interferences.**

When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title without the written authority of the Director, and *then only for the consideration of matters not already adjudicated, sufficient cause being shown.* (emphasis added)

**Issue 1 on Petition Under 37 CFR 1.181(a)**

Can the primary examiner reopen or reconsider prosecution of the proceedings for matters already adjudicated, after a decision by the by the Board of Patent Appeals and Interferences on appeal has become final for judicial review? (see claims 21, 4-38 and 40)

**Discussion of Issue 1**

In the fifth Office Action subsequent to appeal, the Office has once again rejected claims 21, 34-38 and 40 under 35 U.S.C. § 103(a) as being unpatentable over Acosta et al. (U.S. Patent No. 6,643,625). These same claim rejections are based on exactly the same law and arguments, as well as exactly the same cited reference that, when taken on appeal, were reversed by the Board of Patent Appeals and Interferences. This issue is whether the primary

examiner can re-assert exactly the same rejections after appeal that were previously reversed by the Board of Patent Appeals and Interferences.

Under 37 CFR 1.198, when a decision by the Board of Patent Appeals and Interferences has become final for judicial review, the prosecution of the proceeding before the primary examiner may be reopened or reconsidered by the primary examiner only for consideration of matters not already adjudicated. Since claims 21, 34-38 and 40 have already been adjudicated, applicant requests withdrawal of the rejections of these claims.

### **Issue 2 on Petition Under 37 CFR 1.181(a)**

Can the primary examiner reopen or reconsider prosecution of the proceedings for matters already adjudicated by merely changing the cited law to 35 U.S.C. § 103(a) from 35 U.S.C. § 102(e) while maintaining the same cited single reference and same arguments, after a decision by the by the Board of Patent Appeals and Interferences on appeal has become final for judicial review? (see claims 1-20, 22-33, 39 and 41-42)

### **Discussion of Issue 2**

In the fifth Office Action subsequent to appeal, the Office has rejected claims 1-20, 22-33, 39 and 41-42 under 35 U.S.C. § 103(a) as being unpatentable over Acosta et al. (U.S. Patent No. 6,643,625). These claim rejections are based on the same single cited reference and substantially the same arguments that were used in the rejection of these claims in the fourth Office Action preceding appeal based 35 U.S.C. § 102(e). The only difference between the fifth Office Action and the fourth Office Action is that the Examiner changed the 35 U.S.C. § 102(e) rejections in the fourth Office Action to 35 U.S.C. § 103(a) rejections in the fifth Office Action, and merely adding that “it would have been obvious to one of ordinary skill in the art...” No additional references were cited beyond the single reference by Acosta

et al. (U.S. Patent No. 6,643,625). This issue is whether the primary examiner can re-assert the same rejections after appeal that were previously reversed by the Board of Patent Appeals and Interferences by merely changing the basis for rejection from 35 U.S.C § 102(c) to 35 U.S.C. § 103(a), while using the same arguments and same single reference, without sufficient cause being shown, as required under 37 CFR 1.198.

Under 37 CFR 1.198, when a decision by the Board of Patent Appeals and Interferences has become final for judicial review, the prosecution of the proceeding before the primary examiner may be reopened or reconsidered by the primary examiner only for consideration of matters not already adjudicated, and only with sufficient cause being shown. Since claims 1-20, 22-33, 39 and 41-42 have already been adjudicated and sufficient cause has not been shown to reopen or reconsider the proceedings, applicant requests withdrawal of the rejections of these claims. Furthermore, the arguments made by the applicant to support the reversal of these claims on appeal were based on the lack of establishment of a *prima facie* case for anticipation by Acosta et al. (U.S. Patent No. 6,643,625). The same arguments also support the lack of establishment of a *prima facie* case for obviousness under Acosta et al. (U.S. Patent No. 6,643,625).

### **Summary**

Based on the foregoing discussion, Petitioner requests that the claim rejections of claims 1-42 in the fifth Office Action be withdrawn and that U.S. Patent Application No. 09/518,837 be allowed to issue.

If there are any remaining issues regarding this matter, please contact me so that they may be addressed as expeditiously as possible.

Respectfully Submitted,

4 April 2007

Date

/Douglas D. Russell/

Douglas D. Russell

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DATE	ACTION	COMMENTS
March 3, 2000	File patent application 09/518,837	4 Independent claims, 38 dependent claims
March 4, 2003	First Office Action mailed	35 U.S.C. § 102(b) rejection of claims based on a first set of references, McClelland (5,689,650) and Pepe (5,742,905)
June 4, 2003	Responded to first Office Action	Amended claims and presented arguments rebutting claim rejections
September 8, 2003	Second Office Action mailed	35 U.S.C. § 103(a) rejection of claims based on a second set of references, Davidson (5,699,527) and CompliancePro (by Phil Britt)
December 8, 2003	Responded to second Office Action	Presented arguments rebutting claim rejections
March 9, 2004	Third and Final Office Action mailed	35 U.S.C. § 103(a) rejection of claims based on the second set of references, Davidson (5,699,527) and CompliancePro (by Phil Britt)
May 7, 2004	Responded to third and Final Office Action	Presented arguments rebutting claim rejections and submitted evidence of commercial success and details of CompliancePro website
June 8, 2004	Filed Notice of Appeal	
July 2, 2004	Advisory Action mailed	Applicant's arguments rejected by the Office
August 2, 2004	Filed Appeal Brief	Presented arguments rebutting claim rejections and submitted evidence of commercial success and details of CompliancePro website
November 4, 2004	Prosecution re-opened with fourth Office Action mailed	The Office reopened prosecution and rejected claims under 35 U.S.C. §§ 102(c) and 103(a) based on a reference by Acosta et al (6,643,625)
December 21, 2004	Responded to fourth Office Action and requested Appeal reinstatement	Presented arguments rebutting claim rejections under Acosta, and requested reinstatement of Appeal with Supplemental Appeal Brief
March 24, 2006	Board of Patent Appeals and Interferences reversed rejections of all claims 1-42.	Judges Barrett and Blankenship reversed the rejections of claims 1-42, with concurrence by Judge Levy.
February 7, 2007	Fifth Office Action mailed.	The Office rejected all claims 1-42 under 35 U.S.C. § 103(a) as being unpatentable over Acosta et al (6,643,625). The BPAI previously reversed 35 U.S.C. § 103(a) rejections of claims 21, 34-38 and 40.

TABLE 1

File Date 03/03/00	First Office Action 03/04/03	Response Filed 06/04/03	Second Office Action 09/08/03	Response Filed 12/08/03	Third and Final Office Action 03/09/04	Response Filed 05/07/04	Filed Appeal Brief 08/02/04	Fourth Office Action After Reopened Prosecution 11/04/2004	Response/Suppl Appeal Brief Filed 12/21/04	All Rejections Reversed on Appeal 03/24/06	Fifth Office Action 02/07/07	
Claim Number												
1-1	✓ R1 102b	C	✓ R3,4 103a	P	✓ R3,4 103a	P	A, P	✓ R5 102e	A, P	RR	✓ R5 103a	
2-1	✓ R1 102b	C	✓ R3,4 103a	P	✓ R3,4 103a	P	A, P	✓ R5 102e	A, P	RR	✓ R5 103a	
3-D2	✓ R1 102b	C	✓ R3,4 103a	P	✓ R3,4 103a	P	A, P	✓ R5 102e	A, P	RR	✓ R5 103a	
4-D3	✓ R1 102b	C	✓ R3,4 103a	P	✓ R3,4 103a	P	A, P	✓ R5 102e	A, P	RR	✓ R5 103a	
5-D2	✓ R1 102b	C	✓ R3,4 103a	P	✓ R3,4 103a	P	A, P	✓ R5 102e	A, P	RR	✓ R5 103a	
6-D5	✓ R1 102b	C	✓ R3,4 103a	P	✓ R3,4 103a	P	A, P	✓ R5 102e	A, P	RR	✓ R5 103a	
7-D5	✓ R1 102b	C	✓ R3,4 103a	P	✓ R3,4 103a	P	A, P	✓ R5 102e	A, P	RR	✓ R5 103a	
8-D5	✓ R1 102b	C	✓ R3,4 103a	P	✓ R3,4 103a	P	A, P	✓ R5 102e	A, P	RR	✓ R5 103a	
9-D3	✓ R1 102b	C	✓ R3,4 103a	P	✓ R3,4 103a	P	A, P	✓ R5 102e	A, P	RR	✓ R5 103a	
10-D3	✓ R1 102b	C	✓ R3,4 103a	P	✓ R3,4 103a	P	A, P	✓ R5 102e	A, P	RR	✓ R5 103a	
11-D10	✓ R1,2 103a	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 102e	A, O	RR	✓ R5 103a	
12-D2	✓ R1 102b	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 102e	A, O	RR	✓ R5 103a	
13-D2	✓ R1 102b	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 102e	A, O	RR	✓ R5 103a	
14-D5	✓ R1 102b	C	✓ R3,4 103a	P	✓ R3,4 103a	P	A, P	✓ R5 102e	A, P	RR	✓ R5 103a	
15-D14	✓ R1 102b	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 102e	A, O	RR	✓ R5 103a	
16-D12	✓ R1 102b	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 102e	A, O	RR	✓ R5 103a	
17-D13	✓ R1 102b	C	✓ R3,4 103a	P	✓ R3,4 103a	P	A, P	✓ R5 102e	A, P	RR	✓ R5 103a	
18-D13	✓ R1 102b	C	✓ R3,4 103a	P	✓ R3,4 103a	P	A, P	✓ R5 102e	A, P	RR	✓ R5 103a	
19-D13	✓ R1 102b	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 102e	A, O	RR	✓ R5 103a	
20-D13	✓ R1 102b	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 102e	A, O	RR	✓ R5 103a	
21-D14	✓ R1,2 103a	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 103a	A, O	RR	✓ R5 103a	
22-1	✓ R1 102b	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 102e	A, O	RR	✓ R5 103a	
23-D2	✓ R1 102b	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 102e	A, O	RR	✓ R5 103a	
24-D22	✓ R1 102b	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 102e	A, O	RR	✓ R5 103a	
25-1	✓ R1 102b	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 102e	A, O	RR	✓ R5 103a	
26-D25	✓ R1 102b	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 102e	A, O	RR	✓ R5 103a	
27-D25	✓ R1 102b	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 102e	A, O	RR	✓ R5 103a	
28-D25	✓ R1 102b	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 102e	A, O	RR	✓ R5 103a	
29-D27	✓ R1 102b	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 102e	A, O	RR	✓ R5 103a	
30-D25	✓ R1 102b	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 102e	A, O	RR	✓ R5 103a	
31-D25	✓ R1 102b	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 102e	A, O	RR	✓ R5 103a	
32-D25	✓ R1 102b	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 102e	A, O	RR	✓ R5 103a	
33-D32	✓ R1 102b	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 102e	A, O	RR	✓ R5 103a	

TABLE 2



File Date 03/03/00	First Office Action 03/04/03	Response Filed 06/04/03	Second Office Action 09/08/03	Response Filed 12/08/03	Third and Final Office Action 03/09/04	Response Filed 05/07/04	Filed Appeal 08/02/04	Fourth Office Action After Reopened Prosecution 11/04/2004	Response/Suppl Appeal Brief Filed 12/21/04	All Rejections Reversed on Appeal 03/24/06	Fifth Office Action 02/07/07		
Claim Number													
34-D27	✓ R1,2 103a	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 103a	A, O	RR	✓ R5 103a		
35-D27	✓ R1 102b	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 103a	A, O	RR	✓ R5 103a		
36-D27	✓ R1,2 103a	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 103a	A, O	RR	✓ R5 103a		
37-D27	✓ R1,2 103a	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 103a	A, O	RR	✓ R5 103a		
38-D27	✓ R1,2 103a	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 103a	A, O	RR	✓ R5 103a		
39-D25	✓ R1 102b	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 102e	A, O	RR	✓ R5 103a		
40-D25	✓ R1 102b	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 103a	A, O	RR	✓ R5 103a		
41-D25	✓ R1 102b	O	✓ R3,4 103a	O	✓ R3,4 103a	O	A, O	✓ R5 102e	A, O	RR	✓ R5 103a		
42-D23	✓ R1 102b	O	✓ R3,4 103a	C	✓ R3,4 103a	P	A, P	✓ R5 102e	A, P	RR	✓ R5 103a		

I - Independent

✓ - Rejected

D - Dependent

= - Allowed

A - Appealed

RR - Reject Reversed

R1 - U.S. Patent No. 5,689,650 by McClelland et al.

R2 - U.S. Patent No. 5,742,905 by Pepe et al.

R3 - U.S. Patent No. 5,699,527 by Davidson

R4 - Compliance Pro by Phil Britt

R5 - U.S. Patent No. 6,643,625 by Acosta et al.

O - Original

C - Currently Amended

P - Previously Presented

102 - Novelty Reject

103 - Obvious Reject

TABLE 2